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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,039	04/18/2001	William Whitehead	85939.000189	9206

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EXAMINER

STRIMBU, GREGORY J

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,039

Applicant(s)

WHITEHEAD, WILLIAM

Examiner

Gregory J. Strimbu

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002 and 17 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-17, 20-23 and 42-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-17, 20-23 and 42-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 October 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I Figures 2-5

Group II Figures 14-25

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, 6-8, 13-17 and 21-23 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

During a telephone conversation with Brian B. Shaw on October 26, 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 4, 5 and 26-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-12, 18, 19, 24, 25, 33-36 and 38-41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

The information disclosure statement filed September 18, 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the German references DE 199 08 902 and DE 197 44 240 and the French reference FR 2 356 961 have not been considered. It should be noted that only the second page of the international search report has been received. This second page only listed French reference FR 2 732 927.

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Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on October 17, 2002 have been approved.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-9, 13-15, 17, 20-23, 42-63 and 65-74 are rejected under 35

U.S.C. 102(e) as being clearly anticipated by Atkinson et al.

Claims 1-3, 6-9, 13-15, 17, 42-44, 47-50, 55-57, 60-63, 65-67 and 70-74 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Publication No. 198 41 180. German Patent Publication No. 198 41 180 discloses a vehicular weatherseal comprising an elongate polymeric body 4 including a monolithic sealing portion (not numbered, but comprising the end portion of the body 4), a seating channel 8 extending along a longitudinal dimension of the polymeric body and a light generating

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line 9 connected to the body and extending along a longitudinal dimension of the body for generating and emitting light.

German Patent Publication No. 198 41 180 also discloses a vehicular weather seal assembly 1' comprising a weatherseal body having a longitudinal dimension, and a hollow bulb shaped sealing portion 20 and a fiber optic line 9 connected to the body for emitting light along a portion of the longitudinal dimension.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 64, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 198 41 180 as applied to claims 1-3, 6-9, 13-15, 17, 42-44, 47-50, 55-57, 60-63, 65-67 and 70-74 above. German Patent Publication No. 198 41 180 is silent concerning the distance the light generating light extends.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to manufacture the seal with the light generating line extending along less than the entire length of the polymeric body.

Claims 64, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. as applied to claims 1-9, 13-15, 17, 20-23, 42-63 and 65-74 above. Atkinson et al. is silent concerning the distance the light generating light extends.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to manufacture the seal with the light generating line extending along less than the entire length of the polymeric body.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 198 41 180 as applied to claims 1-3, 6-9, 13-15, 17, 42-44, 47-50, 55-57, 60-63, 65-67 and 70-74 above. German Patent Publication No. 198 41 180 discloses only one fiber optic light line.

However, it would have been obvious to one of ordinary skill in the art to provide the seal of German Patent Publication No. 198 41 180 with two fiber optic light lines since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. as applied to claims 1-9, 13-15, 17, 20-23, 42-63 and 65-74 above. Atkinson et al. discloses only one fiber optic light line.

However, it would have been obvious to one of ordinary skill in the art to provide the seal of Atkinson et al. with two fiber optic light lines since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

Applicant's arguments filed October 17, 2002 have been fully considered but they are either not persuasive or moot in view of the new grounds of rejection.

With respect to the applicant's comments alleging that German Patent Publication No. 198 41 180 failing to disclose a monolithic sealing portion, the examiner respectfully disagrees. As shown in figure 1 of German Patent Publication No. 198 41 180, the seal portion 4 comprises a monolithic structure. It should be noted that the claims only require the sealing portion be monolithic rather than the sealing portion and the polymeric body being monolithic.

With respect to the applicant's comments alleging that German Patent Publication No. 198 41 180 fails to disclose a hollow bulb shaped sealing portion, the examiner respectfully disagrees. German Patent Publication No. 198 41 180 clearly discloses a hollow bulb shaped sealing portion 8. It should be noted that because the applicant is claiming the subcombination of the weatherseal, the prior art only need be

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capable of performing as the applicant's invention performs to be a valid reference.

Therefore, the bulb shaped sealing portion 8 meets the applicant's claim language because it is capable of functioning as a seal.

The applicant's remaining comments are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The applicant has amended the claims to include *inter alia* a monolithic sealing portion. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a stylized flourish at the end.

Gregory J. Strimbu
Primary Examiner
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January 22, 2003